

REMARKS

By this Amendment, claims 1, 11, 17 and 26 have been amended. No claims have been canceled and no new claims have been added to the application. Accordingly, claims 1-9, 11-14 and 17-29 are pending in the application. No new matter has been added.

In the prior Office Action, the Examiner rejected claims 1-9, 11-14 and 17-29 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. First, the Examiner contends that the specification does not support claiming that the supercritical fluid remains in a supercritical state while the first fluid is flowed outside the extraction chamber. Second, the Examiner contends that the specification does not support the purportedly contrary recitations that the particulate suspension is flowed out of the extraction chamber and into a collection vessel when such suspension is not "yielded" until the later step of draining the collection vessel occurs.

With respect to the first issue raised by the Examiner, applicants have amended each of the independent claims pending in the application (i.e., claims 1, 11, 17 and 26) to delete the language the Examiner objected to and to clarify that the particulate suspension is separated from the first solvent by flowing the first solvent out of the extraction chamber with the supercritical fluid via a backpressure regulator, as expressly disclosed in the specification at page 7, lines 15-18 (paragraph [0035]). In light of the amendments, reconsideration is respectfully requested.

With respect to the second issue raised by the Examiner, applicants believe that the Examiner has ascribed a meaning to the word "yield" that was unintended by applicants. Applicants intended for the word "yield" to mean "to give up" rather than "to form". In order to eliminate any ambiguity, applicants have amended each of the independent claims pending in the application (i.e., claims 1, 11, 17 and 26) to delete the word "yield" and to clarify that the particle suspension is either drained from the collection vessel (claims 1 and 11) or collected from the extraction chamber after the extraction chamber has been depressurized (claims 17 and 26), as expressly taught and disclosed in the specification at page 7, lines 20-26 (paragraph [0036]) and lines

27-31 (paragraph [0037]), respectively. In view of the amendments to claims 1, 11, 17 and 26, reconsideration of the rejections under 35 U.S.C. §112, first paragraph is respectfully requested.

Also in the prior Office Action, the Examiner rejected claims 1-9 and 11-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner states that in each of claims 1 and 9, it is not understood what fluid or material is separately flowed from the aqueous particle suspension. The Examiner also stated that it is not understood how the aqueous suspension is formed in the extraction chamber and flowed to the collection vessel since it is now claimed that such suspension is not "yielded" until the later step of draining the collection vessel.

Applicants believe the claim rejections under 35 U.S.C. §112, second paragraph, have been fully addressed and overcome by the amendments made to claims 1 and 11 in response to the claim rejections under 35 U.S.C. §112, first paragraph. It is clear that the supercritical fluid extracts the first solvent from the solution in the extraction chamber, causing the solute to precipitate into the second solvent and thereby form a particulate suspension (i.e., precipitated solute particles suspended in the second solvent, which is water in claim 11). The first solvent flows out of the extraction chamber with the supercritical fluid via a backpressure regulator. The particulate suspension separately flows out of the extraction chamber and into a collection vessel, where it is drained. Reconsideration of the rejection of claims 1-9 and 11-14 is respectfully requested.

Also in the prior Office Action, the Examiner rejected claims 1-9, 11-14 and 17-29 under 35 U.S.C. §102(e, f and g) as being anticipated by Chattopadhyay et al., U.S. Pat. 7,083,748 (hereinafter referred to as "the '748 Patent"), as fully supported by Provisional Application 60/445,944, filed February 7, 2003. The Examiner also rejected the same claims under 35 U.S.C. §103(a) as being unpatentable over the same reference.

In response, applicants have submitted the Declaration of Pratibhash Chattopadhyay under 37 C.F.R. §1.132. Dr. Chattopadhyay is a co-inventor of the

subject matter claimed in the above-identified patent application. He is also a co-inventor of the subject matter disclosed and claimed in the '748 Patent.

Dr. Chattopadhyay's Declaration shows that all of the co-inventors of the subject matter claimed in the above-identified patent application and all of the co-inventors of the subject matter disclosed and claimed in the '748 patent were under an obligation to assign the inventions to Ferro Corporation at the time the respective inventions were made, and that the above-identified patent application and the '748 patent are commonly owned. Robert W. Huff is a co-inventor of the subject matter claimed in the above-identified patent application, but was not an inventor of the subject matter disclosed in the '748 patent. Robert W. Huff obtained knowledge of the subject matter disclosed in the '748 patent before it was disclosed to the public by virtue of working with the other co-inventors at Ferro Corporation, and thus had knowledge of the subject matter disclosed in the '748 patent when the inventions claimed in the above-identified patent application were made.

Dr. Chattopadhyay's Declaration further shows that the subject matter disclosed in the '748 patent is different than the subject matter claimed in the above-identified patent application. The subject matter disclosed in the '748 patent relates to the production of a particle suspension by contacting an "emulsion" with a supercritical fluid in an extraction chamber. An "emulsion" comprises at least two liquid phases, namely a continuous phase and a discontinuous phase. The subject matter claimed in the above-identified application relates to the production of a particle suspension by contacting a "solution" with a supercritical fluid, wherein the "solution" comprises a first solvent that is soluble in the supercritical fluid, a second solvent that is substantially insoluble in the supercritical fluid and is at least partially soluble in or miscible with the first solvent, and a solute that is soluble in the first solvent and is substantially insoluble in the second solvent and the supercritical fluid. The "solution" defined in the above-identified application is not an "emulsion" because the second solvent is at least partially soluble or miscible with the first solvent and thus the "solution" does not comprise at least two liquid phases.

In view of the foregoing, the Examiner's rejection of the claims in the present application as being anticipated by or obvious in view of the '748 patent and/or U.S.

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Amendment "C" After Final dated January 24, 2008
Reply to Office action of November 20, 2007

Provisional App. 60/445,944, filed February 7, 2003, cannot be maintained.

Reconsideration is therefore respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge the same to Deposit Account No. 18-0160, Order No. FER-14668.001.

Respectfully submitted,

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